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JUN 15 2009

OFFICE OF PETITIONS

In re Application of :
Fries, et al. :
Application No. 10/787,345 : **DECISION**
Filed: 26 February, 2004 :
Attorney Docket No. 11000060-0040 :

This is a decision on the petition filed on 21 April, 2009, under the provisions of 37 C.F.R. §1.137(b), seeking revival of the application as having been abandoned due to unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.

Nevertheless, such statement is being construed as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.¹ In the event that such an inquiry has not been made, Petitioner must make such an inquiry.

If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, Petitioner must notify the Office.

The petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

¹ See 37 C.F.R. §10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioners attentions always are directed to the Commentary at MPEP §711.03(c) for guidance as to satisfying the requirements for relief under 37 C.F.R. §1.137.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply to the non-final Office action mailed on 19 December, 2007, with reply due absent extension of time on or before 19 March, 2008.

The application went abandoned by operation of law after midnight 19 March, 2008.

On 12 May, 2008, Petitioner's office sought status in the matter after it appears that Counsel Michael W. Maddox (Reg. No. 47,764) moved from one law firm to another, and on 27 August, 2008, Petitioner's office attempted to revoke/submit a power of attorney, however, the Office Noticed the former office of Mr. Maddox that the required certificate pursuant to 37 C.F.R. §3.73(b) had not been received.

The Office mailed the Notice of Abandonment on 23 September, 2008.

On 30 October, 2008, Petitioner filed a revocation/power of attorney, which the Office acknowledged on 7 November, 2008.

On 13 November, 2008, Petitioner filed a petition averring, *inter alia*, non-receipt, and sought withdrawal of the holding of abandonment pursuant to 37 C.F.R. §1.181, but failed to comply with the express requirements for showing required herein as set forth at MPEP 711.03(c)(I)—including but not limited to the statement of search and non-discovery, the description as to the docketing and/or calendaring system and its reliability, and required documentary support of the docket sheet (or file jacket cover) of the instant application and the due date calendar for the reply in question. Moreover, there is no statement from Mr. Maddox as the registered practitioner who oversaw the matter at the time of abandonment, nor from Petitioner. Thus, Petitioner failed to demonstrate that the Office action in question was not received (and so docketed, that the system provides sufficient and reasonable reliability and that it therefore does not appear either on the application docket sheet or on the due-date calendar for reply. Petitioner

averred that the delay was unavoidable and expressly invoked the provisions of the regulations under 37 C.F.R. §1.137(a), and, the fee was authorized and was charged to Deposit Account 19-3140, however, Petitioner failed to satisfy the regulatory (showing) requirements pursuant to the rule. The petition was dismissed on 15 December, 2008. From the history of this matter, as set out above, it was apparent that Petitioner's office attempted to move the prosecution of the instant application from one law firm to another and in doing so did not keep track of the Office action in question. This not being the basis for a petition to revive pursuant to 37 C.F.R. §1.137(a) or a request to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181, the petition was dismissed on 15 December, 2008.

On 17 February, 2009, Petitioner reasserted his petitions pursuant to 37 C.F.R. §1.137(a) and pursuant to 37 C.F.R. §1.181—and threw in a suggestion of a request for relief pursuant to 37 C.F.R. §1.137(b). Once again Petitioner failed to satisfy the requirements as set out in the decision of 15 December, 2008, and failed to satisfy the requirements for relief pursuant to 37 C.F.R. §1.137(b) as set out above, and the petition was dismissed on 16 March, 2009—with a caution to Petitioner to ensure that any person making the statement of unintentional delay was the proper person to make the statement of unintentional delay (i.e., aware of the nature of the delay or having made the requisite inquiry).

On 21 April, 2009, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, with a statement of unintentional delay and a reply was in the form of an amendment.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.

Nevertheless, such statement is being construed as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.² In the event that such an inquiry has not been made, Petitioner must make such an inquiry.

If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, Petitioner must notify the Office.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

² See 37 C.F.R. §10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁵))

As to Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

⁴ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.


Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

The instant application is released to the Technology Center/AU 2614 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the OTC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁶ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.